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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,486	07/11/2000	Hai-Ying Zhu	07678/062004	9740

7590

03/26/2002

Paul T Clark  
Clark & Elbing LLP  
176 Federal Street  
Boston, MA 02110

EXAMINER

KATCHEVES, KONSTANTINA T

ART UNIT PAPER NUMBER

1636

DATE MAILED: 03/26/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/613,486

Applicant(s)

ZHU ET AL.

Examiner

Konstantina Katcheves

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 11-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 1-18 are pending in the instant application.

#### ***Election/Restrictions***

Applicant's election without traverse of Group II, claims 3-10, in Paper No. 7 is acknowledged. Upon further consideration, the species election set forth on pages 3-4 of the Restriction Requirement mailed 3 October 2001 has been withdrawn. Accordingly, claims 3-10 have been examined.

#### ***Specification - Sequence Compliance***

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. The instant application does not provide a computer readable form or paper copy of the sequence listing in the specification. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. " 131 and 132.

A complete reply to this office action requires that Applicant complies with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37

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CFR 1.136(a). Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

Applicant should note that a reply to a notice to comply with the sequence rules should NOT be sent to the 20231 zip code address for the United States Patent and Trademark Office because mail sent to this zip code is destined for irradiation. The following information is also provided on the website.

Please direct all replies to the United States Patent and Trademark Office via one (1) of the following:

1. Electronically submitted through EFS-Bio  
(<http://www.uspto.gov/ebs/efs/downloads/documents.htm>), EFS  
Submission User Manual - ePAVE)

2. Mailed to:  
**U.S. Patent and Trademark Office**  
**Box Sequence, P.O. Box 2327**  
**Arlington, VA 22202**

3. Mailed by Federal Express, United Parcel Service or other delivery  
service to:  
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**Crystal Plaza Two, Lobby, Room 1B03**  
**Arlington, Virginia 22202**

4. Hand Carried directly to the Customer Window at:  
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### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,197,948 ('948 patent).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention recited in the prior patent is substantially the same as or obvious variations of the instant claims. The invention of the '948 patent recites an isolated DNA molecule encoding a protein or polypeptide of a grapevine leafroll virus (type 2) wherein the protein or polypeptide is a heat shock 10 protein. The instant claims also broadly recite DNA encoding any

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protein or polypeptide of grapevine leafroll virus and more specifically a heatshock 70 protein. Moreover, the claims of the instant Application are drawn to an expression system comprising a DNA construct encoding a protein of the grapevine leafroll virus and host cell transformed with such a construct. It would have been obvious to one of ordinary skill in the art at the time the invention was made to transform cells with a construct comprising DNA encoding proteins of grapevine leafroll virus. It is well within the purview of the ordinary skilled artisan and well known in recombinant techniques to transform cells with heterologous nucleic acids such that one of ordinary skill in the art would have reasonable success with the technique. Moreover, the ordinary skilled artisan would be motivated to transform cells with proteins of the virus in order to confer resistance to the virus. Therefore, the instant claims are not patentably distinct from one another.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's claims are broadly drawn to nucleic acids encoding any peptide of grapevine leafroll virus, a polyprotein, an RNA dependent RNA polymerase, a heat shock 70 protein, a heat

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shock 90 protein, a diverged coat protein, and a coat protein. Each of these proteins represent a broad genus of polypeptides as well as a broad genus of nucleic acids encoding them.

The specification must teach the limitations of the invention with such clarity and sufficient detail such that one skilled in the art can reasonably conclude that Applicant was in possession of the claimed invention. The specification may describe the invention with sufficient identifying characteristics such as words, structures, figures, diagrams, and formulas. Applicant, however, has failed to do so. Each of these nucleic acid sequences represents a very broad genus of molecules. The specification does not disclose what features are necessary and required for any one of these nucleic acid molecules to maintain their respective activities. Applicant fails to specifically disclose what sequences these genes embrace nor does the specification disclose mutations, additions, or deletions that can be tolerated to produce these nucleic acid molecules and maintain their characteristics as heat shock protein, coat protein or any grapevine leafroll virus protein. Absent such teachings and guidance as to the structure-function relationship of these sequences, the specification does not describe the claimed genres in such full, clear, concise and exact terms so as to indicate that Applicant had possession of the invention at the time of filing of the present application. Absent such a description, the skilled artisan could not envision the genres embraced by each of the genes above.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konstantina Katcheves whose telephone number is (703) 305-1999. The examiner can normally be reached on Monday through Friday 7:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3388.

Konstantina Katcheves, J.D.  
March 25, 2002



**REMY YUCEL, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600**